

## REMARKS

### 1. Summary of the Office Action

Claims 1-52 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. patent no. 6,044,363 to Mori *et al.* (hereinafter “Mori”) in view of U.S. pat’s no.’s 6,415,269 to Dinwoodie (hereinafter “Dinwoodie”), and 6,449,601 to Friedland *et al.* (hereinafter “Friedland”).

### 2. Response to § 112 Rejection

It should be noted that the operative standard for determining whether the definiteness requirement of the relevant statute has been met is “whether those skilled in the art would understand what is claimed when the claim is read in the light of the specification.” The Beachcombers Intn’l, inc. v Wilde Wood creative products, Inc., 31 USPQ 2d 1653, 1656 (Fed. Cir. 1994) (citing Orthokinetics, Inc. v Safety Travel Chairs, Inc., 806 F.2d, 1565, 1 USPQ 2d 1081, 1088 (Fed. Cir. 1986)).

Applicant has amended claims 20, 21, 30 and 34 to correct typographical errors that were present in those claims as originally filed. Applicant respectfully submits that the amendment has overcome the § 112 rejection and that one skilled in the art would understand the claims, as amended, when read in light of the specification.

### 3. Response to § 103 Rejection

Applicant respectfully traverses this rejection for the reasons set out below, and requests the Examiner’s reconsideration.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**THE PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL CLAIM LIMITATIONS, WHEN CONSIDERED SINGULARLY OR IN COMBINATION.**

Claims 1, 26, and 27 have been rejected by the Examiner. Claim 1, which is representative of the group, includes the following limitation:

displaying a note indicator to indicate an association of the note with the selected aspect of the on-line auction when displaying information concerning the selected aspect on a display unit of a network device.

(Claim 1, emphasis added). Figure 7 of the specification illustrates an exemplary note indicator 124 in accordance with an exemplary embodiment of the patent invention displayed next to a username indicating a note associated with the displayed username.

Mori relates to an auction method using a communications network, whereby remote bidders participate in the auction by sending order information to an auctioneer over the communications network. In particular, Mori discloses displaying a product information screen, which may include a “product image 219 such as a color photograph.” (Col. 6, lines 1-5). Figure 3 of Mori illustrates a product image 219 displayed together with a variety of other product information. For example, in accordance with Mori, the product image relates to a product and is displayed alongside other product information, such as a product number, color, a growing area, a shipping person, and an amount.

In contrast to claim 1, Mori does not disclose displaying a note indicator to indicate an association of a note with a selected aspect of the on-line auction when displaying information concerning the selected aspect. Instead, Mori discloses a product image directly associated with a product. The product image disclosed in Figure 3 of Mori is not a note indicator, and does not indicate an association of a note with a selected aspect of the on-line auction.

Furthermore, neither Dinwoodie nor Friedland disclose displaying a note indicator to indicate an association of a note with a selected aspect of the on-line auction when displaying information concerning the selected aspect. Consequently, claim 1 is not obvious and is not rendered unpatentable by the combination of Mori, Dinwoodie, and Friedland under 35 U.S.C. § 103(a). For the same reasons, claims 26 and 27 are not rendered unpatentable by the combination of Mori, Dinwoodie, and Friedland under 35 U.S.C. § 103(a).

Claims 2-14 and 28-40 depend from claim 1 and claim 27, respectively. Therefore, claims 2-14 and 28-40 are not rendered unpatentable under 35 U.S.C. § 103(a). Claims 15 and 41

were also rejected by the Examiner. Claim 15, which is representative of the two claims, includes the following limitation:

automatically invoking the note creation function from one of a plurality of administrative applications of the network-based auction facility, where the note creation function associates the note with the user, as identified by an administrator of the network-based auction facility to the note creation function.

(Claim 15, emphasis added). In one exemplary embodiment of the present invention explained more fully with respect to Figure 4 in paragraphs 32 and 33 of the specification, an administrator of a network-based auction facility may identify a user and, utilizing the note creation function, associate a note with the identified user.

As discussed above, Mori relates to an on-line auction method. At best, Mori discloses a purchasing person, or client, retrieving product information using a web browser, and entering automated auction conditions and rules. (Col. 5, lines 60-65 and Col.6 Lines 10-49). However, Mori does not disclose automatically invoking a note creation function, where the note creation function associates a note with a user, as identified by an administrator of a network-based auction facility.

Friedland relates to a system and method for distributing a live auction over the Internet to remote bidders. As such, Friedland facilitates communication between remote bidders and an auctioneer. However, Friedland does not disclose automatically invoking a note creation function, where the note creation function associates the note with a user, as identified by an administrator of a network-based auction facility.

Similarly, Dinwoodie relates to a method of communicating bids from remote bidders to an auction site over a communications network. In contrast to the requirements of claim 15, Dinwoodie does not disclose automatically invoking a note creation function, where the note creation function associates the note with a user, as identified by an administrator of a network-based auction facility.

Consequently, because the combination of Mori, Friedland and Dinwoodie fails to disclose each and every limitation of claim 15, claim 15 is not obvious in view of the combination and is not rendered unpatentable under 35 § U.S.C. 103(a). For the same reasons, claim 41 is not rendered unpatentable under 35 § U.S.C. 103(a).

Claims 16-25 and 42-52 depend from claims 15 and 41, respectively. Therefore, claims 16-25 and 42-52 are also patentable over the combination of Mori, Friedland and Dinwoodie.

In light of the above, Applicant respectfully submits that the rejection under 35 U.S.C. § 103 has been overcome, and withdrawal of this rejection is therefore respectfully requested.

#### 4. Conclusion

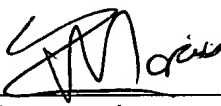
Having tendered the above remarks and amended the claims as indicated herein, Applicant respectfully submits that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

It should furthermore be noted that the above amendments to the claims have not been made within view to overcoming any prior art of which the Applicant is aware, or that has been cited in the present Office Action. The above amendments have been made only with a view to modifying the form of the claims.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact André Marais at (408) 947-8200 ext. 204.

Respectfully submitted,  
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